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OFFICE OF PETITIONS

In re Application of :
Coston et al. :
Application No. 10/812,978 : DECISION DISMISSING
Filed: 31 March, 2004 : PETITION
Atty Docket No. 1857.0700003 :

This is a decision on the petition filed on 2 July, 2004, requesting that the above-identified application be accorded a filing date of 31 March, 2004, with drawing Figures 4c and 5d as a part of the original disclosure.

On 31 March, 2004, the application was filed.

On 14 June, 2004, the Office of Initial Patent Examination (OIPE) mailed a Notice of Omitted Items in a Nonprovisional Application stating that the application had been accorded a filing date of 31 March, 2004, but that Figures 4c and 4d described in the specification appeared to have been omitted from the application.

In response, on 2 July, 2004, the present petition was filed. Petitioner concedes that Figures 4c and 4d were inadvertently omitted from the application, but states that the above-identified application is a continuation-in-part of Application No. 10/270,556, and incorporated the entire disclosure of the prior application by reference.

The petition is dismissed.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing drawings were in fact deposited in the PTO with the application papers must file a petition (and the

appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted drawings in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, however, petitioner neither asserts that the missing drawings were deposited on 31 March, 2004, nor request the 2 July, 2004 (the date the drawings were supplied), filing date. Rather, petitioners state in the first sentence of the specification that the present application is a continuation-in-part of Application No. 10/270,556 "which [is] incorporated herein by reference in [its] entirety."

MPEP 201.06(c) states that:

. . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition.
(emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, the drawing of Figures 4c and 4d is not new matter if it was a part of the disclosure of the prior application.

Petitioner should file the drawing of Figures 4c and 4d as a preliminary amendment. If Figures 4c and 4d are filed as a preliminary amendment, they will be reviewed by the examiner for new matter.

The application will be processed using only the application papers present on filing. The one (1) sheet of drawings containing Figures 4c and 4d will not be processed for examination, but will be retained in the application file.

As this petition was necessitated by applicants' filing error rather than an error on the part of the Office, the petition fee will not be refunded.

The application is being returned to Initial Patent Examination Division for further processing with a filing date of 31 March, 2004, using only the application papers filed on that date.

Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.



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Office of Petitions